

Appl. No. : 09/696,841
Filed : October 25, 2000

REMARKS

In response to the Office Action mailed October 7, 2002, please reconsider the above-captioned application in consideration of the above amendments and the following remarks.

All Claims Are Currently In Condition For Allowance

The Examiner rejected Claims 1-17 under 35 U.S.C. § 103(a) as unpatentable over well known landscape members in view of Leguillon. Claims 16 and 17 have been cancelled, and independent Claims 1 and 12 have been amended to clarify the scope of protection afforded by these claims. Applicant respectfully traverses the Examiner's rejection and combination of references, and contends that the cited art does not teach or suggest all of the limitations of the claims.

Leguillon's invention is directed to a magnetic key holder that is flexible so that the magnet will not become easily detached when applied to a nonplanar surface. The reason Leguillon uses this structure is because magnetic key holders are intended to be placed on out-of-sight metal surfaces, and that such surfaces tend not to be flat planes. Col. 1, ll. 14-43. Leguillon teaches an envelope 21 made by "molding, dipping, extruding or otherwise" and which defines a central space 22 into which a key presumably fits. The space 22 is closed by folding a flap 24 over the open end 23 of the envelope and tucking the flap 24 into a slot 25. Col. 2, ll. 17-22, Figs. 1, 10.

With regards to "well known landscape members", the Examiner states "It is widely accepted to hide a key under a landscape member such as a rock."

A number of limitations of the claims are not shown in the cited art. For example, the "landscape member configured to be placed in an exposed position in an outdoor landscape, the body having at least one slot formed on a side thereof," as recited in Claim 1 is not shown. Further, the "strip substantially covering the opening of said slot" is not shown. With regard to Claim 12, cutting a slot in a body that comprises an article of material suitable for use in an outdoor landscape is not shown in the cited art.

Landscape members are vastly different than the Leguillon device, which is formed by "molding, dipping, extruding or otherwise." For example, the Leguillon device is intended to be hidden out of sight, and is specially configured to magnetically adhere to out-of-sight, nonplanar surfaces. Thus, its form is constructed around the space 22, with no regard to aesthetic properties, and no need to consider such properties when forming the space 22. In contrast, the

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recited landscape member must be suitable for use in an exposed position in an outdoor landscape. As such, the recited slot must accommodate, both in its placement and its method of formation, the properties and shape of the landscape member. Leguillon does not contemplate or satisfy such requirements. The space 22 of Leguillon does not teach forming a slot in a landscape member that is used in an outdoor landscape. Further, Leguillon teaches no methods of forming such a slot or any acceptable shape of such a slot.

The “well known landscape members” cited by the Examiner also teach nothing in connection with a slot or strip. Rather, the Examiner notes that it is accepted to hide keys under landscape members such as rocks. In fact, people have been hiding keys under rocks for years, and have lamented the negative results such as losing the key in dirt and/or corrosion of the key from exposure. Applicant contends that this fact gravitates in Applicant’s favor, and demonstrates that there has been a long felt but unsolved need for Applicant’s invention.

Since the art cited by the Examiner does not disclose all of the limitations of the claims, a *prima facie* case of obviousness has not been satisfied.

Moreover, Applicant contends that there is no teaching or motivation to combine Leguillon with a landscape member, as these references are directed to totally different approaches. As discussed above, Leguillon is designed from the beginning to be a key holder, and its structure and construction is centered around this purpose. In contrast, a landscape member, in order to be suitable for use in an exposed position in an outdoor landscape, must be primarily directed to its function as a landscape member. Such is the case with rocks under which people may hide keys. Nothing about such a rock is adapted to accommodate or hold the key. Rather, the rock is simply a visible member behind which a key happens to be hidden. In contrast, the Leguillon device is itself specifically designed to be hidden, and has no aesthetic function at all. These devices are directed to different primary functions, and are not interchangeable in any way. As such, there is no motivation to combine Leguillon with any landscape member.

Design Choice Rejection Is Improper

The Examiner contends that the slot shape would have been an obvious matter of design choice. Applicant respectfully disagrees, and contends that the Examiner’s “design choice” rejection is improper.

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A rejection of claims as being merely a "design choice" is not appropriate when the claimed structure or method solves a particular problem that has not been contemplated or addressed by the prior art. The structure in the amended claims is directed to features that solve particular problems never before contemplated or addressed.

For example, dependent Claim 11 recites that the slot is generally semicircular in shape. If a landscape member comprises a hard member, such as a natural or artificial rock, forming the slot can be time consuming and difficult. Obviously, Leguillon's "molding, dipping, extrusion or otherwise" is not applicable or helpful in this instance. Also, as discussed in the specification (at least page 4, ll. 4-5 and page 5, ll. 19-22.), it is desirable to protect the key from corroding. Thus, the shape of the slot should allow relatively easy closure. The recited semicircular shape of Applicant's invention solves these problems. A slot having the recited semicircular shape can be quickly formed by, for example, a circular rotating grinder blade (see page 3, l. 31), and can be formed sufficiently thin and with a sufficiently consistent cut so as to be sealable by a strip. Similar reasoning can be applied to others of the original and newly-added claims. These are problems that were never contemplated or dealt with before Applicant invented the claimed invention. As such, Applicant contends that the "design choice" rejection is improper.

The cited art does not disclose several of the recited limitations. In addition, the cited art does not teach or suggest all of the limitations of the claims, which address and solve a long felt but unsolved need, and which address and solve particular problems never before contemplated. Further, there is no motivation to combine Leguillon with a landscape member. As such, Applicant respectfully requests the Examiner to withdraw the rejection of the claims.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

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The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,

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Dated: 4/7/03

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